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IN THE

Supreme Court of the United States

OCTOBER TERM, 1949.

No. 105

THE DAVISON CHEMICAL CORPORATION,
Petitioner,

vs.

JOLIET CHEMICALS, INC., DES PLAINES OIL COMPANY, JOLIET CHEMICALS, LTD., and KENNETH F. NASH,

Respondents.

RESPONDENTS' BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI.

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The Scheffer Press, Inc.—FInancial 6-2694

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IN THE

Supreme Court of the United States

OCTOBER TERM, 1949.

No. 862

THE DAVISON CHEMICAL CORPORATION,
Petitioner,

vs.

JOLIET CHEMICALS, INC., DES PLAINES OIL COMPANY, JOLIET CHEMICALS, LTD., and KENNETH F. NASH,
Respondents.

RESPONDENTS' BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI.

Plaintiff's petition for writ of certiorari and brief in support thereof are completely without merit. The decision of the Circuit Court of Appeals for the Seventh Circuit is entirely correct, and for the reasons given therein.

Plaintiff's brief and petition fail to mention that the process of the Connolly patent in suit is identical with the process of the prior art Patrick patent, which even disclosed it to be preferable to wash the silica gel in "heated" water (R. 31, lines 84, 85). The Connolly patent in suit merely provided an explanation of the advantages of the heated water wash in controlling pore size; but no new step was added. It may be that this explanation was the result of a discovery, but under the doctrine announced by this Court in *Funk Brothers Seed Co.* v. *Kalo Inoculant Co.*, 333 U. S. 127, it did not entitle the discoverers thereof

to a patent unless as a result thereof a new process utilizing such discovery was also found. This the patentees did not do.

The argument that the present case is in conflict with the decisions of other Courts of Appeal is completely without support. The conflict of decisions doctrine is normally applicable only where conflicting decisions with respect to the same patent have been handed down by different Circuit Courts of Appeal. See *Keller* v. *Adams-Campbell Co.*, 264 U. S. 314, 319. Not only has the patent in suit never been involved in other litigation, but the decisions of the various cases cited are based on different facts, and in no way out of harmony.

The present case involved a patent on the manufacture of silica gel. Petitioner's cited case in the Second Circuit, *Schering Corp.* v. *Gilbert*, 153 F. 2d 428, 432 (this case and one other are the only cases cited by petitioner which were not considered by the Seventh Circuit Court of Appeals) involved a patent on a complex chemical product for use in gall bladder radiology. The Court merely held that the product was new. No process was involved. The other case now first cited (*McClurg* v. *Kingsland*, 1 How. 202) was decided on another point, the question of the presence of invention merely being assumed for the purpose, and not really decided. The Ninth Circuit case, *Vitamin Technologists* v. *Wisconsin Alumni Research Foundation*, 146 F. 2d 941, 949 involved a process for the preparation of food substances so that all or a part of their activatable content would be activated by exposure to actinic rays. In the last mentioned case, the Court brought out that, page 948:

> "a patent whose validity is attacked is anticipated even though the prior patent failed to state and the inventor did not know that his invention brought the process into operation."

In the present case the patent in suit is not only not the same patent as that involved in the other allegedly conflicting cases in other circuits, but is for entirely different subject matter.

In the present case, the defendants have on file a counterclaim for unfair competition (R. 4), the issues of which were divided out and deferred pending determination of the patent issues. In view of the complete absence of any point warranting certiorari, and of any significant new case cited by petitioner, and because of the further delay in proceeding with the counterclaim for unfair competition which will inevitably result if the petition is not acted upon during the present term, it is respectfully requested that a prompt order denying the petition be forthcoming.

Respectfully submitted,

JULES L. BRADY,
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June 13, 1950.